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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,495	07/11/2003	Christian John Lee	C-389 DIV	3998
32172	7590	12/15/2006	EXAMINER	
DICKSTEIN SHAPIRO LLP 1177 AVENUE OF THE AMERICAS (6TH AVENUE) NEW YORK, NY 10036-2714			LE, HOA VAN	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/617,495

**Applicant(s)**

LEE ET AL.

**Examiner**

Hoa V. Le

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

This is in response to Papers filed on 06 November 2006.

I. The group conference has decided on 11 December 2006 that:

(1) The rejection under 35 U.S.C. 102(b) as being anticipated by Krishnan et al (5,725,646) is withdrawn. Instead, the rejection under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al (5,725,646) is added.

(2) The rejection under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al (5,725,646) considered in view of Best (EP 0 079 746) and Wasilewski (5,372,635) is maintained.

(3) The rejection under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al (5,725,646) considered in view of Wasilewski (5,372,635) is maintained.

II. Claims 1-5, 10 and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al (5,725,646).

Krishnan et al disclose, teach and suggest a method for lithographic printing comprising using a printing ink composition comprising from up to 60 wt% of water, up to 10 wt% of glycerol rewetting agent, up to 30 wt% of a CI Pigment

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Black 6 and 7, up to 70 wt% of a binder, up to 5 wt% a surfactant selected from known of sorbitan esters which is read on

“fatty acid esters such as T-Maz® 80 wherein such sorbitan derivatives include POE(20) sorbitan monooleate (BASF)(HLB 15.0)” in the instant application on page 9, line 13-15.

The nonionic surfactants of the known classes of acetylenic glycols and ethoxylated glycols is withdrawn since applicants submit evidences and state on the record that none of the nonionic surfactants of the known classes of acetylenic glycols, ethoxylated glycols has a hydrophilic/lipophilic balance of about 8-20 as claimed. However, an allowed claim or patent would have no value when someone show that at least one nonionic surfactant of the known classes of acetylenic glycols, ethoxylated glycols has a hydrophilic/lipophilic balance of about 8-20 as claimed. It is now clearly pointed out and set forth the record. Please also see the whole disclosure of the applied reference, especially on col.3:16-40, 4:1-17

The language “self-dampening”, “having a hydrophilic/lipophilic balance of about 8-20 hydrophilic/lipophilic balance” or the like is a property of a material and considered inherent. For a patentability of a property of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual

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evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the same or obviously the same claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference, such as at least the known nonionic surfactant of the known class of sorbitan esters which is read on

“fatty acid esters such as T-Maz® 80 wherein such sorbitan derivatives include POE(20) sorbitan monooleate (BASF)(HLB 15.0)” in the instant application on page 9, line 13-15. In the absence of convincing evidence to the contrary, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to go out and select “sorbitanmonooleate (BASF)(HLB 15.0)” which is read on at least one known nonionic surfactant within the known class of sorbitan esters for a reasonable expectation of a nonionic additive benefit as disclosed, taught and suggested in Krishnan et al.

Applicant's arguments filed 06 November 2006 have been fully considered but they are not persuasive.

The rejection under 35 U.S.C. 102(b) as being anticipated by Krishnan et al (5,725,646) is with drawn.

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Applicants urge that the specification is related to “the image is hydrophobic”. It is correct. However, the arguments have and are given a little value. It is not allowed to read any embodiment from the limited specification in a claim. None of the claim has been limited to hydrophilic image as urged.

It is also correct that at least the instant method claims are different from those the applied reference that the instant claim method does not provide a hydrophobic image since the composition of the instant claimed method does not contain a conventional or known amount of an oil or hydrophobic agent. Applicant should show or provide a convincing evidence for the record and an allowability of the claims.

Applicants recognize that Krishnan et al disclose, teach and suggest the use of glycerol but urge that additional compound having about the same property are also disclosed. They are not applied in the above rejection.

At least “fatty acid esters such as T-Maz® 80 wherein such sorbitan derivatives include POE(20) sorbitan monooleate (BASF)(HLB 15.0)” in the instant application on page 9, line 13-15 is found to read on one of the known nonionic surfactant of the known class of sorbitan esters in the applied reference. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to go out and select

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“sorbitanmonooleate (BASF)(HLB 15.0)” which is read on at least one known nonionic surfactant within the known class of sorbitan esters for a reasonable expectation of a nonionic additive benefit as disclosed, taught and suggested in Krishnan et al.

The nonionic surfactants of the known classes of acetylenic glycols and ethoxylated glycols is withdrawn since applicants submit evidences and state on the record that none of the nonionic surfactants of the known classes of acetylenic glycols, ethoxylated glycols has a hydrophilic/lipophilic balance of about 8-20 as claimed. However, an allowed claim or patent would have no value when someone show that at least one nonionic surfactant of the known classes of acetylenic glycols, ethoxylated glycols has a hydrophilic/lipophilic balance of about 8-20 as claimed. It is now clearly pointed out and set forth the record.

The language “self-dampening”, “having a hydrophilic/lipophilic balance of about 8-20 hydrophilic/lipophilic balance” or the like is a property of a material and considered inherent. For a patentability of a property of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the

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same or obviously the same claimed functional property as set forth on the record, such as at least the known nonionic surfactant of the known class of sorbitan esters which is read on

“fatty acid esters such as T-Maz® 80 wherein such sorbitan derivatives include POE(20) sorbitan monooleate (BASF)(HLB 15.0)” in the instant application on page 9, line 13-15.

The record shows that applicants narrowly or insufficient provide evidences on the record and state on the record that there is no known nonionic surfactant of the known class of the applied sorbitan esters have a hydrophilic/lipophilic balance of about 8-20 hydrophilic/lipophilic balance”. Evidence can be seen in the instant application on page 9, lines 13-15 in the contrary to the limited or insufficient evidences and statements on and for the record. An allowed claim or patent would have no value when someone shows to the same or obviously the same claimed functional property as set forth on the record.

III. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al (5,725,646) considered in view of Best (EP 0 079 764) and Wasilewski et al (5,372,635).



Krishnan et al disclose, teach and suggest a method for lithographic printing comprising using a printing ink composition comprising from up to 60 wt% of water, up to 10 wt% of glycerol rewetting agent, up to 30 wt% of a CI Pigment Black 6 and 7, up to 70 wt% of a binder, up to 5 wt% a surfactant selected from known of sorbitan esters which is read on

“fatty acid esters such as T-Maz® 80 wherein such sorbitan derivatives include POE(20) sorbitan monooleate (BASF)(HLB 15.0)” in the instant application on page 9, line 13-15.

The nonionic surfactants of the known classes of acetylenic glycols and ethoxylated glycols is withdrawn since applicants submit evidences and state on the record that none of the nonionic surfactants of the known classes of acetylenic glycols, ethoxylated glycols has a hydrophilic/lipophilic balance of about 8-20 as claimed. However, an allowed claim or patent would have no value when someone show that at least one nonionic surfactant of the known classes of acetylenic glycols, ethoxylated glycols has a hydrophilic/lipophilic balance of about 8-20 as claimed. It is now clearly pointed out and set forth the record. Please also see the whole disclosure of the applied reference, especially on col.3:16-40, 4:1-17

The language “self-dampening”, “having a hydrophilic/lipophilic balance of about 8-20 hydrophilic/lipophilic balance” or the like is a property of a material

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and considered inherent. For a patentability of a property of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the same or obviously the same claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference, such as at least the known nonionic surfactant of the known class of sorbitan esters which is read on

“fatty acid esters such as T-Maz® 80 wherein such sorbitan derivatives include POE(20) sorbitan monooleate (BASF)(HLB 15.0)” in the instant application on page 9, line 13-15.

Krishnan et al do not specify an amount of a mineral oil as that in claims 6-9, Best at page 4, third paragraph is cited to show the known use of up to about 50 wt% of mineral oil additive in water/oil ink emulsion on page 10, lines 1-15 for the advantage of providing an oil potion in a water/oil emulsion.

Krishnan et al do not specify the additionally known nonionic surfactants and mineral oil in claims. Wasilewski et al at col.2:47-49 and 3:16-27 is further cited to show the additionally known nonionic surfactants hydrophilic/lipophilic

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balance for the advantage of reducing surface tension among chemical molecules in the art and a mineral oil to wet a hydrophobic portion in a printing image.

Since the above references are all related to a printing process and ink compositions, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include oil portion from Best and Wasilewski et al in Krishnan et al ink compositions for a reasonable expectation of providing an oil portion in water/oil ink emulsion to wet a hydrophobic portion in a printing image as disclosed, taught and suggested in Best and Wasilewski et al and to further use the known nonionic surfactant for the advantage of reducing surface tension among chemical molecules as disclosed, taught and suggested in Wasilewski et al.

Applicant's arguments filed 06 November 2006 have been fully considered but they are not persuasive.

Applicants urge that the limited or insufficient evidence that some alkylphenol ethoxylate nonionic surfactant may have a hydrophilic/lipophilic balance of less than 8-20 hydrophilic/lipophilic balance. They are acknowledged. They are also do not applied in the above rejection. An allowed claim or patent would have no value when someone shows to the same or obviously the same claimed functional property as set forth on the record.

The record also shows that no conventional additive soap is applied in the above rejection. The instant claims are open with the language “comprising”. They do not exclude a known or conventional additive as urged.

The language “self-dampening” or the like is a functional of a material. For a patentability of a property of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. There are no convincing evidence on the record that Wasilewski et al ink composition does not have a property of “self-dampening” as urged. The arguments alone are not a factual evidence. They have and are given little value. Please also see the contrary arguments and statements in the appeal brief in parent application 10/117,910.

Applicants point out that both Best and Wasilewski et al ink compositions contain mineral oil. It is correct.

The language “self-dampening” or the like is a functional of a material. For a patentability of a property of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. There are no convincing

evidence on the record that Best ink composition does not have a property of “self-dampening” as urged. The arguments alone are not a factual evidence. They have and are given little value. Please also see the contrary arguments and statements in the appeal brief in parent application 10/117,910.

IV. Claims 6-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al (5,725,646) considered Wasilewski et al (5,372,635).

Krishnan et al disclose, teach and suggest a method for lithographic printing comprising using a printing ink composition comprising from up to 60 wt% of water, up to 10 wt% of glycerol rewetting agent, up to 30 wt% of a CI Pigment Black 6 and 7, up to 70 wt% of a binder, up to 5 wt% a surfactant selected from known of sorbitan esters which is read on

“fatty acid esters such as T-Maz® 80 wherein such sorbitan derivatives include POE(20) sorbitan monooleate (BASF)(HLB 15.0)” in the instant application on page 9, line 13-15.

The nonionic surfactants of the known classes of acetylenic glycols and ethoxylated glycols is withdrawn since applicants submit evidences and state on the record that none of the nonionic surfactants of the known classes of acetylenic glycols, ethoxylated glycols has a hydrophilic/lipophilic balance of about 8-20 as

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claimed. However, an allowed claim or patent would have no value when someone show that at least one nonionic surfactant of the known classes of acetylenic glycols, ethoxylated glycols has a hydrophilic/lipophilic balance of about 8-20 as claimed. It is now clearly pointed out and set forth the record. Please also see the whole disclosure of the applied reference, especially on col.3:16-40, 4:1-17

The language “self-dampening”, “having a hydrophilic/lipophilic balance of about 8-20 hydrophilic/lipophilic balance” or the like is a property of a material and considered inherent. For a patentability of a property of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the same or obviously the same claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference, such as at least the known nonionic surfactant of the known class of sorbitan esters which is read on

“fatty acid esters such as T-Maz® 80 wherein such sorbitan derivatives include POE(20) sorbitan monooleate (BASF)(HLB 15.0)” in the instant application on page 9, line 13-15.

Wasilewski et al further disclose, teach and suggest additional non-ionic surfactants in the claims on col.3:16-27 for the advantage of reducing surface tension among chemical molecules in the art and an amount of mineral oil on col.2:47-49 for the advantage of wetting a hydrophobic portion in a printing image.

Since the above references are all related to a printing process and ink compositions, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a mineral oil for a reasonable expectation of providing an oil portion in water/oil ink emulsion to wet a hydrophobic portion in a printing image and to further use the known nonionic for the advantage of reducing surface tension among chemical molecules as disclosed, taught and suggested and obtained in Wasilewski et al.

Applicant's arguments filed 06 November 2006 have been fully considered but they are not persuasive.

Applicants urge that the limited or insufficient evidence that some alkylphenol ethoxylate nonionic surfactant may have a hydrophilic/lipophilic balance of less than 8-20 hydrophilic/lipophilic balance. They are acknowledged. They are also do not applied in the above rejection. An allowed claim or patent

would have no value when someone shows to the same or obviously the same claimed functional property as set forth on the record.

The record also shows that no conventional additive soap is applied in the above rejection. The instant claims are open with the language “comprising”. They do not exclude a known or conventional additive as urged.

The language “self-dampening” or the like is a functional of a material. For a patentability of a property of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. There are no convincing evidence on the record that Wasilewski et al ink composition does not have a property of “self-dampening” as urged. The arguments alone are not a factual evidence. They have and are given little value. Please also see the contrary arguments and statements in the appeal brief in parent application 10/117,910.

V. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
11 December 2006.

HOA VAN LE  
PRIMARY EXAMINER

A handwritten signature in black ink that reads "Hoa Van Le". The signature is written in a cursive, flowing style.